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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,738	01/27/2004	Roland Hengerer	10022/580	2842
28164 7590 02/13/2007 ACCENTURE CHICAGO 28164 BRINKS HOFER GILSON & LIONE P O BOX 10395 CHICAGO, IL 60610			EXAMINER DESTA, ELIAS	
			ART UNIT 2857	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/766,738

Applicant(s)

HENDERER, ROLAND

Examiner

Elias Desta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Explanation of rejection

Claim rejection – 35 U.S.C. 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-14 are rejected under 35 U.S.C.101 because the claimed invention is directed to non-statutory subject matter and for lack of patentable utility.

Non-statutory subject Matter

In reference to claims 10 and 11: Determining a reference scent ratio (σ_0) does not amount to a “useful, concrete and tangible” outcome.

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is “concrete, tangible and useful”. Referring to the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” in determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible and concrete.”

In the instant claims, determining whether the impermeable seal is broken based on the reference scent ratio does not amount to a useful, concrete and tangible result. In order to make

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the outcome as “a useful, concrete and tangible” output, a subsequent step (s) would have to be taken so that the output of the process or method have to be conveyed to the end user.

Utility

In reference to claims 1, 8, 12 and 14: the disclosed invention is inoperative and therefore lacks utility. The base or reference scent value is arbitrarily chosen and then compared to another scent value in order to establish a ratio; however, the ratio defined in the system as a whole may not produce real world value that provides substantial or well-established utility. The unknown function $\eta(\xi, t)$ cannot be identical for the two different sensors of the electronic nose with different decay constant. If $\eta(\xi, t)$ is considered the same, then $\alpha_1 = \alpha_2, I_1 = I_2, \dots$ etc. which would make the alleged equation invalid. It is not apparent how an unknown function $\eta(\xi, t)$ with so many variable factors that is applied to two different sensors would have exactly the same functional representation without having a significant error factor.

In reference to claims 9 and 13: the claim is not supported by a well-established utility because applicant's statement of the characteristics of the first and second volatile components is not known or defined. The volatile identification code is not described in the specification as having an interpretable code, such as color, barcode or other means known in the art. A person having ordinary skill in the art would not have known how these volatile components sprayed on an object define a quantifiable data to establish a volatile identification code.

In reference to claims 10 and 11: claims 10 and 11 are inoperative and therefore lack utility. As noted above, the unknown function $\eta(\xi, t)$ cannot be the identical for the two different sensors of the electronic nose with different decay constant. Therefore, the scent ratio is an over simplification or derivation of an equation from two scent intensity equations (see pages 4-5 of

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the instant specification) which are based upon on the unknown or indefinite variable $\eta(\xi, t)$ assigned for the two sensors. As a result, the scent ratio as noted in equation 2 of the instant application (see page 5 of the instant specification) would not be realized in claims 10 and 11.

Claim rejection – 35 U.S.C. 112

3. Claims 1-14 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Response to Argument

4. Applicant's arguments filed November 9, 2006 have been fully considered but they are not persuasive.

Utility requirement,

The Examiner would like the Applicant to revisit the instant specification as noted on paragraph 27. The Examiner believes the assessment of the invention, as noted in the previous office action is based on the right analysis. The Applicant specification does not specify that the unknown function eta ($\eta(\xi, t)$) is different for the two sensors. The amendment to the specification does not reflect what applicant has presented in page 14 of the response to the office action (see Amendment dated November 9, 2006). In fact, paragraph 27 of the instant specification does not correctly make the assumption because the unknown function eta ($\eta(\xi, t)$) is the same for both sensors. Therefore, the Examiner is maintaining the 35 U.S.C. 101 rejections

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for lack of utility since the unknown function is not explained within a reasonable clarity in the specification to support the alleged claims.

If the Applicant presents the specification with better form and the right analysis then the Examiner would give further consideration (For instance, see pages 14 and 15 of the response to the office action dated November 9, 2006). In the absence of clear explanation and correct assumption, it is evident that the specification in its present form does not provide the right assessment to support the utility requirement of the amended and newly added claims.

The Examiner has carefully considered the argument presented in regard to claim 9 and is not convinced that the response addresses the underlying issue with the claim. Applicant stated paragraphs 33-37 of the instant specification supports claim 9. However, this section addresses the structural elements related to the electronic nose and associated devices rather than the product identification code. The claim certainly is not supported by the specification to carry out the alleged method of marking of an object.

Non-statutory subject Matter

In reference to claims 10 and 11: determining a reference scent ratio (σ_0) does not amount to a “useful, concrete and tangible” outcome. In the instant claims, determining whether the impermeable seal is broken based on the reference scent ratio does not amount to a useful, concrete and tangible result. In order to make the outcome as a “useful, concrete and tangible” output, a subsequent step (s) would have to be taken so that the output of the process or method have to be conveyed to the end user.

The Examiner acknowledges and accepts the amendment to the specification and it does not add new matter.

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gilbert et al. (IDE Article, 'Individually Recognizable Scent Marks on Flowers Made by a Solitary Bee') teaches a method of using observational and experimental data to test the scent markings left by solitary bee in certain type of flowers.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elias Desta whose telephone number is (571)-272-2214. The examiner can normally be reached on M-Th (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571)-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elias Desta
Examiner
Art Unit 2857

- E.d

- January 22, 2007


EDWARD RAYMOND
PRIMARY EXAMINER